

## **REMARKS**

Claims 1-14 remain pending in the application. Minor amendments have been made to claim 1 to correct a typographical error noted in the Office Action and to conform the further references to the “compound of Formula I or the oligomer thereof or both” to the antecedent, initial reference in claim 1. Applicants believe the amendment should be entered as it raises no new issues and complies with a requirement of form expressly set forth in the Office action.

The Examiner is respectfully requested to reconsider the claims and withdraw the rejection in view of Applicants’ amendments and remarks.

### **Claim Objection**

Claim 1 was objected to for a misspelling. This informality has been corrected.

### **Rejection Under 35 U.S.C. § 103**

Claims 1-14 stand rejected as unpatentable over Sadvary, US Patent Publication 2001/0039324 in view of the “admitted state of the art” in the present specification. Applicants respectfully traverse the rejection and request reconsideration of the claims.

Applicants’ invention provides an unexpected advantage over the expansive group of curing agents from which the Sadvary publication asks the skilled artisan to select. The law is clear that a subgroup possessing a different feature or property may be patentable over a reference disclosing a broad genus that includes the subgroup to which the claims are directed when that reference does not disclose or suggest the selection of the claimed subgroup. *In re Deuel*, 34 U.S.P.Q.2d 1210 (Fed. Cir. 1995) (“a broad genus does not necessarily render obvious each compound

within its scope”); *In re Bell*, 26 U.S.P.Q.2d 1529 (Fed. Cir. 1993) (claim to DNA and RNA molecules with certain human genes patentable over disclosure of amino acid sequences); *In re Jones*, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992) (particular dicamba salt patentable over disclosure of genus of dicamba salts). Compare, *In re Susi*, 169 U.S.P.Q. 123 (C.C.P.A. 1971) (claimed stabilizer obvious from disclosure of genus of compounds, all useful as stabilizers, in combination with disclosure of specific stabilizer with nearly identical structure); *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 U.S.P.Q.2d 1843 (Fed. Cir. 1989) (all compounds disclosed in the reference had the same efficacy as the claimed combination, thus there was a reasonable likelihood of success in choosing any compound).

In the present instance, as in *Deuel* and *Bell*, there can be no expectation of success in random selection among the Jacobs curing agents. The Sadvary publication provides no direction at all on how to select those curing agents that will be acceptable in the present method from those that will not be useful because of toxicity to aquatic life. There is no appreciation of the problems of aquatic toxicity in the Sadvary publication (or the Jacobs patent) or any awareness that not all of the curing agents within its general description will avoid this regulatory concern. Without this, there can be no reasonable expectation of success. There is, in fact, no motivation in the reference to carry out the claimed method.

Further, as pointed out in the present specification in paragraph \_\_, the only commercially available compound of Formula I was unsuitable for this application. This remained the case at the time of Applicants’ invention.

Thus, with regard to all claims, the prior art did not provide the motivation or teaching needed for the person of ordinary skill in the art to arrive at the present invention.

Finally, with regard to claim 4, the Formula I compound prepared using an alcohol would not have an R group comprising an oxygen. The oxygen atom of an alcohol is the one shown as the linking oxygen atom, the "O" of the "OR." Thus claim 4 is patentable over the cited art for the additional reason that there is no suggestion to use a compound of Formula I in which the R group includes an oxygen atom.

For all of these reasons, Applicants respectfully submit that the claims are patentable over the cited art and respectfully request reconsideration and allowance of the claims.

#### Conclusion

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,



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